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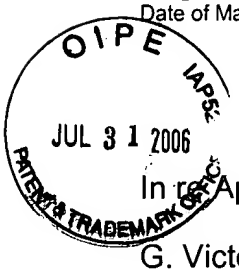


Our Case No. 10022/217

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

G. Victor Guyan et al.

Serial No. 09/667,637

Filing Date: September 22, 2000

For LINE ITEM DATA PROCESSING

Examiner: Frenel, Vanel

Group Art Unit No. 3626

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the Final Rejection mailed May 31, 2006, in the above-identified application as to Claims 2-11, 13-22 and 24-33. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided. Claims 1, 12 and 23 have been cancelled.

REMARKS

A. Claims 2-11

In the Final Rejection, claims 2-11 were rejected under 35 U.S.C. § 103 as being obvious in view of Field, U.S. Patent No. 6,073,104 and Little et al., U.S. Patent No. 5,359,509. Independent claim 4 recites 1) "maintaining a vendor database on the insurance host server," 2) "placing at least one order for at least one line item from the insurance host server to a vendor" and 3) "tracking the order on the insurance host server." The Final Rejection relies on arguments made in the previous Office Action mailed on

October 11, 2005 to show that Field discloses the above mentioned "maintaining," "placing" and "tracking" processes. In particular, the previous Office Action relied on a passage at column 6, lines 32-50 of Field as disclosing the above mentioned processes. As shown at pages 10 and 11 of Applicants' Amendment of January 4, 2006, the passage does not disclose any of the three processes. The Final Rejection does not address Applicants' arguments regarding the inadequacy of the passage, which is improper under MPEP § 706.07.

The Final Rejection at pages 5-8 quotes a second passage of Field starting at column 15, line 24 and ending at column 16, line 30 as disclosing the three processes. A review of the second passage reveals that there is no mention of an insurance host server. There is no mention in the passage of either a vendor database or maintaining a vendor database on an insurance host server. Page 8 of the Final Rejection appears to be relying on the underlined passage of that page, which mentions tracking the fees of various financial intermediaries, as disclosing the recited vendor database and maintaining process. The underlined passage does not mention maintaining a vendor database on an insurance server in the manner recited in claim 4.

The second passage is also silent as to placing an order with a vendor as recited in claim 4. Indeed, none of the underlined passages at pages 6 and 8 of the Final Rejection mention placing an order with a vendor.

The second passage is also silent as to tracking an order with a vendor with the insurance server. The underlined passages at pages 6 and 8 of the Final Rejection mention tracking daily pools (53g) (page 6) and tracking fees of financial intermediaries (page 8), but not tracking an order with a vendor with an insurance server.

Upon reading the second passage, one of ordinary skill would not understand the second passage as disclosing or suggesting any of the three processes mentioned above. Indeed, as summarized in the Abstract, Field regards a computerized system that allows healthcare providers to access a commercial paper market by selling their patient claims to asset backed commercial paper conduits. Nowhere does Field suggest any processes involving an insurance server or any of the three processes mentioned above and so Field fails to disclose the invention of claim 4. Since Little et al. does not suggest altering Field to perform the claimed "maintaining," "placing" and "tracking" processes, the rejection is improper and should be withdrawn.

Furthermore, dependent claims 5-11 recite various processes that involve the vendor mentioned in claim 4. The Final Rejection has relied on the same passages in the previous Office Action mailed on October 11, 2005 as disclosing the processes of claims 5-11. As pointed out in Applicants' Amendment filed on January 4, 2006, the passages are silent as to any processes involving a vendor and are also silent to a number of processes recited in the claims, such as entering, editing, upgrading vendor information and various ways of sending an order to a vendor, their rejections are improper as well. It is noted that the Final Rejection has not disputed that the passages do not disclose or suggest the recited processes.

B. Claims 13-22

Claims 13-22 were rejected under 35 U.S.C. § 103 in the Final Office Action as being obvious in view of the same Patents to Field and Little et al. Independent Claim 15 recites a system that has a memory that stores a program that includes instructions for

fulfilling payment of a line item based on evaluation of line item data, wherein such fulfilling includes 1) "maintaining a vendor database on the insurance host server," 2) "placing at least one order for at least one line item from the insurance host server to a vendor" and 3) "tracking the order on the insurance host server." The above three items of claim 15 correspond to the three items mentioned previously with respect to claim 4. Accordingly, the rejection of claim 15 is improper for at least the same reasons given above in Section A with respect to claim 4.

Furthermore, dependent claims 16-22 recite various processes that correspond to those in claims 5-11, respectively, and so their rejections are improper for the same reasons given above in Section A with respect to claims 5-11.

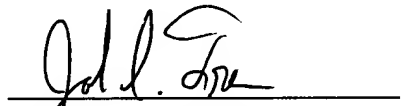
C. Claims 24-33

Claims 24-33 were rejected under 35 U.S.C. § 103 in the Final Office Action as being obvious in view of the same Patents to Field and Little et al. Independent claim 26 recites a computer readable medium that contains instructions for controlling a computer system that involves a method that includes fulfilling payment of a line item based on evaluation of line item data, wherein such fulfilling includes 1) "maintaining a vendor database on the insurance host server," 2) "placing at least one order for at least one line item from the insurance host server to a vendor" and 3) "tracking the order on the insurance host server." The above three items of claim 26 correspond to the three items mentioned previously with respect to claim 4. Accordingly, the rejection of claim 26 is improper for at least the same reasons given above in Section A with respect to claim 4.

Furthermore, dependent claims 27-33 recite various processes that correspond to those in claims 5-11, respectively, and so their rejections are improper for the same reasons given above in Section A with respect to claims 5-11.

In summary, the Examiner has clearly failed to meet his burden to establish a *prima facie* case of unpatentability of the pending claims in the present Office Action. Accordingly, the rejections should be withdrawn and the claims allowed.

Respectfully submitted,



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